

REMARKS

Claims 23-33 and 41-61 are pending in the subject application. Applicants' representative confirms the provisional election with traverse of Group III (claims 23-33 and 41). Consequently, claims 1-22 and 34-40 have been cancelled in view of the Restriction Requirement. Claim 30 has been amended. New claims 42-61 have been added (new claim 52 is a combination of original claims 23 and 31). Favorable reconsideration in light of the following remarks is respectfully requested.

The 112 Second Paragraph Rejection

Claims 24-33 are rejected under 35 U.S.C. §112, second paragraph. In the Office Action, it is asserted that utilizing the phrase "at least one of" in claims 24-33 renders these claims indefinite. Further, it is asserted that claims 27-33 are additionally indefinite because if only one of the members listed is selected, then the other members do not further limit the base claim.

It appears from the Office Action that the Examiner believes applicants intended to use a Markush group. However, it is submitted that the subject claims comprise "or" alternative expressions. Thus, the phrase "at least one of" is utilized to convey "or" alternative limitations, which are permissible pursuant MPEP §2173.05(h)(II). As provided in the MPEP, "alternate expressions using "or" are acceptable" and the expression "at least one piece" was held to be an acceptable "or" expression, not in violation of 35 U.S.C. §112, second paragraph. (See MPEP §2173.05(h)(II) *citing In re Gaubert*, 524 F.2d 122, 187 USPQ 664 (CCPA 1975)). The court in *Gaubert* held that "or" alternative phrases such as "one or several pieces," which is synonymous with "at least one piece," "accurately determine the boundaries of protection," and thus, rejection pursuant 35 U.S.C. §112, second paragraph is improper. Accordingly, since "or" alternative expressions (e.g., "at least one of") are permissible pursuant 35 U.S.C. §112, second paragraph, this rejection should be withdrawn. Moreover, the language is clear on its face, and one skilled in the art would readily understand its meaning.

Claims 27-33 further limit the preceding claims as further requirements, not in the preceding claims, are required. For example, in claim 27, specific pad information is set forth, and these bits of information are not necessarily required in claim 26. Thus, the claims do further limit claims from which they depend.

The Anticipation Rejection

Claims 23-33 and 41 are rejected under 35 U.S.C. 102(a) over Moore (US 2001/0029152 A1). In order to establish anticipation, a single prior art document must disclose each and every element of a claim. Here, Moore fails to disclose an *electrical resistance member*, as recited in the subject claims. Since Moore fails to disclose each and every element of the independent claims, Moore cannot anticipate claims 23-33 and 41.

In particular, the subject claims recite utilizing the electrical resistance member in connection with a wafer to facilitate determining wafer characteristics during CMP. As disclosed in applicants' specification, the wafer can include, inter alia, a conducting layer, wherein an electrical resistance member can be located within and isolated from the conducting layer. The resistance of this member can then be obtained and utilized to characterize the CMP process.

The Examiner contends that paragraphs 0055 – 0056, 0044-0046 and 0048-0049 of Moore disclose such an electrical resistance member. However, these sections do not teach or suggest an electrical resistance member, as recited in the subject claims. Paragraphs 0055-0056 disclose a substrate 712 with a conductive layer 713, wherein the resistance of the conductive layer 713 (not an embedded electrical resistance member) is measured and utilized to indicate information related to the planarization. Moore is silent regarding isolating an electrical resistance member within the conductive layer and analyzing the resistance of the member, as recited in the subject claims. Likewise, paragraphs 0044-0046 and 0048-0049 do not mention an electrical resistance member. Paragraphs 0044-0046 merely disclose a carrier

assembly with force, temperature and pH sensors and paragraphs 0048-0049 simply disclose a pressure transducer.

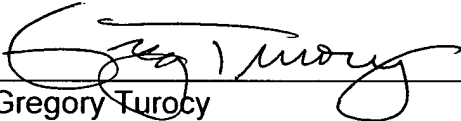
In view of the foregoing, it is readily apparent that Moore does not anticipate Claims 23-33 and 41; therefore, it is respectfully requested that this rejection be withdrawn. The arguments above apply to new claims 42-61 as well.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,

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